



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,095	02/05/2004	John J. Hart III	ECD-0004CIP	3284
29344 7590 02/04/2009				
MILLS & ONELLO LLP				
ELEVEN BEACON STREET				
SUITE 605				
BOSTON, MA 02108				
EXAMINER				
BIBBINS, LATANYA				
ART UNIT		PAPER NUMBER		
2627				
MAIL DATE		DELIVERY MODE		
02/04/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/773,095

Applicant(s)

HART ET AL.

Examiner

LaTanya Bibbins

Art Unit

2627

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-16, 18-24, 26-33 and 35-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 7-16, 18-24, 26-33, 35-40 and 47 is/are allowed.
- 6) ☒ Claim(s) 41-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In the remarks filed on November 6, 2008, Applicant submitted arguments for allowability of pending claims 1-5, 7-16, 18-24, 26-33 and 35-47.

Response to Arguments

2. Applicant's arguments, filed November 6, 2008, with respect to the rejections of claims 1-5, 7-16, 18-24, 26-33 and 35-47 under the first paragraph of 35 U.S.C. 112 have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, a new grounds of rejection is made in view of newly found prior art references.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. ***Claims 41-46 are rejected under 35 U.S.C. 102(e) as being anticipated by***

Gaston (US Patent Number 7,124,441 B1).

Regarding claim 41, Gaston discloses a method for modifying an optical path of an optical medium, the optical medium including a first layer (Figure 1 element 4) adjacent a reflective layer (see the discussion in column 1 lines 50-54 regarding the

reflective layer which is not depicted in the figures) adjacent a data layer (Figure 1 element 2) comprising:

selecting a region of the optical medium be distorted (see the vanishing code illustrated by elements 10 and 10' of Figures 2 and 3 respectively); and

prior to a reading operation of the medium, distorting the region of the optical medium in the reflective layer adjacent the data layer of the optical medium such that a reading operation of data stored in the data layer corresponding to the distorted region is modified, the distorted region maintaining its optical characteristics following irradiation of the distorted region during the reading operation (see the discussion in column 2 lines 58-column 3 line 5 and column 4 line 41-column 5 line 9; specifically note that the mask layer may be an integral part of another layer such as the reflective layer).

Regarding claim 42, Gaston further discloses wherein the first layer comprises a reading layer (Figure 1 element 4 and Figure 2 element 12).

Regarding claim 43, Gaston further discloses wherein distorting the reflective layer comprises distorting the reflective layer along a path of a track and below a protective outer surface (see the discussion in column 4 lines 11-15 and further see Figure 1 and the discussion in column 1 lines 50-54).

Claims 44-46 are drawn to the optical medium corresponding to the method of using same as claimed in claims 41-43 respectively. Therefore optical medium claims 44-46 correspond to method claims 41-43 respectively, and are rejected for the same reasons of anticipation as used above.

Allowable Subject Matter

5. **Claims 1-5, 7-16, 18-24, 26-33, 35-40 and 47** are allowed.
6. The following is an examiner's statement of reasons for allowance:
- Claims 1-5, 7-16, 18-24, 26-33, 35-40 and 47 are allowed for the reasons indicated in the Office Action dated January 2, 2008.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaTanya Bibbins whose telephone number is (571)270-1125. The examiner can normally be reached on Monday through Friday 7:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571 272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LaTanya Bibbins/
Examiner, Art Unit 2627

/Wayne Young/
Supervisory Patent Examiner, Art Unit 2627